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In the Supreme Court of the United States

OCTOBER TERM, 1925

No. 107

THE ALEXANDER MILBURN COMPANY, PETITIONER

v.

DAVIS-BOURNONVILLE COMPANY

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF ON BEHALF OF THE UNITED STATES AS AMICUS CURIAE

PRELIMINARY STATEMENT

This brief is limited to the discussion of the single proposition that the mere disclosure of a structure or process in a patent, which disclosure is sufficient to enable one skilled in the art to construct the machine or carry out the process, will, even though unclaimed, be enough to anticipate and invalidate either an earlier or later patent claiming the same thing, if the filing date of the application of the disclosing patent be earlier than the filing date of the patent sued upon, and even though its date of issue

be later, if the patents were copending, on the ground that it shows prior invention or prior knowledge of the invention.

The question appears to have never been definitely and specifically determined by this Court.

It has been definitely and specifically determined by certain Circuit Courts of Appeals, and the conclusions are diametrically opposed, leaving no authoritative and conclusive rule applicable to and binding upon all the circuits and their courts.

That such a definite and specific ruling is desirable to avoid confusion, to secure stability of business procedure and to reduce litigation, requires no argument.

The Circuit Courts of Appeals for the Second and Seventh Circuits are consistent in holding that such disclosure alone does not amount to an anticipation invalidating a patent issued later than the filing date of the patent containing the unclaimed disclosure, at least where the patent is only pleaded as an anticipating *patent*.

The leading cases supporting this doctrine are in the Seventh Circuit:

> *Farmers' Handy Wagon Co.* v. *Beaver Silo & Box Mfg. Co.*, 236 Fed. 731.

and in the Second Circuit is this instant case.

On the other hand the Sixth Circuit has always held that a patent in evidence under the fourth defense enumerated in Section 4920 R. S.; that is:

> That (the patentee) was not the original and first inventor or discoverer of any material and substantial part of the thing patented.

speaks from its *application* date as to all matters disclosed, even if not claimed therein.

The leading cases in this, the Sixth Circuit, are—

Cochran v. *Zimmerman*, 53 Fed. 801.

Lemley v. *Dobson-Evans Co.*, 243 Fed. 391.

Drewson v. *Hartje Paper Mfg. Co.*, 131 Fed. 734.

Electric Controller & S. Co. v. *Westinghouse E. & Mfg. Co.*, 171 Fed. 83.

Jackson Cushion Spring Co. v. *Adler*, 243 Fed. 386.

Twentieth Century Machinery Co. v. *Loew Mfg. Co.*, 243 Fed. 373.

In harmony with the rule followed by the Sixth Circuit are the decisions of the Patent Office, which in turn are based upon the decisions of the Court of Appeals of the District of Columbia in which the leading cases are:

In re Millet, 96 O. G. 1241, 1901 C. D. 410, 412, 18 App. D. C. 186.

Ex parte Grosselin, 97 O. G. 2977, 1901 C. D. 248.

Ex parte Hammond, 301 O. G. 1051, 1922 C. D. 15.

While it is true that this Court has not definitely and specifically passed upon the concrete question here presented, yet in several cases it has expressed itself in such language that we feel justified in drawing the inference that it has been in sympathy with our contention, or at least is not opposed to it.

General principles will be first discussed and these cases will be considered before discussing the opposing

views of the Courts of Appeals in the different circuits to which allusion has been made above.

It must be remembered that the question brought up by this defense is not that of noninfringement; it is not that of prior patenting; nor of a prior publication; nor is it a question of which of two parties is entitled to a patent as the first inventor, but it is purely and solely *whether the subject matter of a particular patent was* **new** *at the time of the application for it; and whether or not that patent issued in conformity with the statutes; and so is valid as being issued to the first inventor, for something* **new** *and* **not known** *in this country before the patentee's alleged invention of it.*

ARGUMENT

SUMMARY

I. Actual novelty a prerequisite.

II. There is no special virtue or peculiar significance in the claims of a patent by themselves as indicating what was new or unknown at the time of the application.

III. That which is disclosed but not claimed is abandoned or dedicated to the public.

IV. Analogy of interference proceeding in the Patent Office and its long-established practice of considering an earlier disclosure prima facie evidence of earlier invention.

V. The filing of an allowable application is a constructive reduction to practice and evidences a completed invention, even if no actual machine or even model is made.

VI. That which is disclosed in the application for a patent, but not claimed, is presumed to have been known before the applicant's act of invention as set out in the limitation of his claim; this presumption must then necessarily become a conclusion as to any later patent; and this Court has consistently held that no inventor is a true and first inventor, and hence entitled to a patent, if the thing patented or sought to be patented was known to any other before his application.

VII. Analogy of a reissued patent.

VIII. Supreme Court cases clearly supporting petitioner's contention of the invalidity of a later patent when the invention is disclosed in an earlier application even if not claimed.

IX. The third and fourth defenses are separate and distinct and much of the confusion and apparent

diversity of decision is due to improper pleading thereunder, and the introduct on of insufficient evidence to support the pleading.

X. Conclusion.

I

Actual novelty a prerequisite

Section 4886 R. S. provides for the granting of a patent to any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned.

Section 4920 R. S. provides for proof of certain special defenses *any one of which*, if substantiated, must result in a judgment against the patentee.

The fourth of these defenses is: That he (the patentee) was not the original and *first* inventor, etc.

In this connection it has been held that not only must one be a true inventor—that is to say, he must himself have evolved and not have consciously appropriated the idea from another—but he must have been actually the *first* inventor in all time of the thing patented. In other words, no one may have pre-

ceded him in this country—with or without his knowledge—else he is not entitled to the patent under the statute.

Robinson on Patents, Vol. I, Sec. 58;
Pennock v. *Dialogue*, 2 Peters (27 U. S.), 1, 23.

Section 4920 is in effect a provision for the enforcement of the basic principles of Section 4886. It puts teeth into the latter enactment for the benefit of other inventors and the general public.

Reverting for the moment to Section 4886, we find certain prerequisites without which no patent is valid, and upon proof of the failure of which Section 4920 provides a positive defense.

Section 4886 provides that a valid patent may issue only under condition that the invention or discovery be—

First. *New.*

Second. *Useful.*

Third. Not *known* by others in this country before the applicant's invention or discovery thereof.

Fourth. It must not have been *used* by others in this country before his invention or discovery thereof.

Fifth. It must not have been *patented* in this or any foreign country before his invention or discovery thereof.

Sixth. It must not have been described in any *printed publication* in this or any foreign country before his invention or discovery thereof.

Seventh. It must not have been in public use or on sale for more than two years prior to his application.

The only qualification, or limitation, or exception to all these positive requirements needed to procure a valid patent is that if a prior invention, or discovery equivalent to or identical with the supposed invention existed, but was *proved* to have been *abandoned* and *lost*, such abandoned invention when *so proved* to have been abandoned or lost will not bar the issue.

Thus it will be seen that Congress in following the Constitutional provision as to rewarding those who by their own acts furthered and advanced the useful arts emphasized the necessity of *actual novelty* in the thing patented. For the statute provides that it must not only not have been in public use; or on sale (with or without the consent of the inventor); nor have been patented here or abroad by anyone, including the inventor himself (except as provided in 4887); nor have been described in any printed publication here or abroad; nor used by others in this country; but it *must be actually* **new** and **unknown** by others in this country, unless *proved* to have been abandoned—that is, lost to the public so that the public can get no advantage from it.

Knowledge of a thing may be proved to have existed in different ways—by the oral testimony of those who are familiar with the fact, which is not always reliable, or by other tangible evidence, such as a machine itself properly authenticated, which

then speaks for itself, or by an authenticated written description, especially if accompanied by illustrations or structures clearly disclosing the thing so as to be understandable and capable of being constructed or produced by those skilled in the art, to whom it is disclosed. (*Loom Co.* v. *Higgins*, 105 U. S. 580, 594.)

In this statement we do not confuse a written description which shows *per se* and necessarily by its very existence the fact that what it discloses is "known," with a "*printed publication*" which is a separate and distinct statutory bar in itself.

There probably can be no better evidence that knowledge of a thing existed than such documentary evidence fully setting it forth; and when that document bears upon itself a date impressed as a filing date by a recognized official Department, that date is at least *prima facie* evidence of the existence of the thing described at the time set forth, and therefore that it was then "known."

Such is the situation in connection with an application for patent filed in the Patent Office and bearing the official date of filing as recorded by that Office.

Yet the question here at issue leads us further and is concerned with whether or not the mere disclosure in an application of a device identical with that claimed in a patent issued subsequent to the filing date of the application is of the *same* invention as that set out in the claim. In other words, is an invention an "invention" within the meaning of the

statute unless or until it is *claimed* as such? For it is admitted in this suit that the invention claimed in the patent is disclosed in the earlier filed application, but it is contended that the disclosure without claim indicates that the invention was either not perfected as such, or that the knowledge was not a public knowledge until the patent finally issued, when it was too late to constitute an anticipation.

That an invention is completed when an allowable application is filed, sufficiently disclosing an operative structure so that anyone skilled in the art can reproduce and operate it, will be shown later by reference to decisions of this Court.

That it need not be a perfected invention if it complies with the above conditions; and that the knowledge of it is public when one person is shown to have possessed it; that a constructive reduction to practice is accomplished by the filing of such an application; that the disclosing but not claiming an invention justifies the presumption that what is so disclosed was known and used before, and was dedicated to the public; and that such knowledge possessed by one person is a bar to a subsequent inventor will be also shown by such decisions, later discussed.

In solving this question we must consider what a "discovery" or "invention" is, and whether or not the mere formulation of a claim for it acts as a magic charm to change or give an added value to what existed before in the disclosure of a specification.

II

There is no special virtue or peculiar significance in the claims of a patent by themselves as indicating what was actually new or unknown at the time of the application

A patent application serves three purposes:

First, it points out what is admittedly old and known.

Second, it explains what is *believed* by the applicant to be new, and shows its *operation* and how to *construct* it.

Third, it points out the part *claimed* to be new and claims a *monopoly* of it—that is, the right to exclude others from using it.

Furthermore, the law has determined that if the applicant has failed to positively point out what is old or new, and claim the latter as his invention, his disclosure of anything without claim of novelty therefor is a constructive admission that the part shown but not claimed is not as a fact new.

A claim can not be broader or cover more than, and must be construed by, the description from which it is carved; and usually, if taken by itself, would fail to give the information necessary to enable anyone to utilize the invention sought to be covered by it. It is usually less than the whole inventive thought, because its circumference lies within the area of the description as a whole. *Westinghouse E. & Mfg. Co.* v. *Metropolitan E. Mfg. Co.*, 290 F. 661 at 664, [3, 4].

The greater includes the less; how, then, can a claim which is the less, be of more value, or even of as much value as indicative of what is known, than the whole description which includes it?

A claim is not the inception of an idea or invention—it is the *consequence* of the inception, and follows it—is a part of it—delimits the part of which *monopoly* is sought. It can not exist apart from it or before it. It may be less than the whole; if so, the rest, so far from being destroyed or reduced by the limitation of monopoly to a *part*, is, by the very fact that it is set forth but *not* claimed and monopolized, shown to have been known before the claim was carved from it.

The object of a patent claim is to outline or bound the dimension of the *right* to *exclude*, for the sole purpose of exclusion of that bounded part from public use. By the very exclusion of the part which is new from the public use, by claiming a monopoly of it, the part not so excluded is left open to the public as old. This boundary may or may not be coextensive with the real invention disclosed in the application. If it be so coextensive, the monopoly of the whole invention is complete; if not, the portion lying without the wall is open to whoever wishes to use it—*but not monopolize it*. But as embodied in a patent application, both the claimed and the unclaimed portions constitute a statement that the thing, both as disclosed and as specifically claimed, was known, at least at the time of making the application.

Once so set forth, neither is longer a novelty or is later legally discoverable unless proved to have been lost by abandonment.

It has long been determined that a later patent *claiming* an invention may be taken from its filing

date as an anticipation, or at least as disproving invention by a later applicant though earlier patentee of the same thing, for the reason that the setting forth of the invention in the earlier application by the very fact of its being so set forth establishes the date of its filing as the date on which it was known to another than the later alleged inventor. *Kearney* v. *Lehigh Valley R. Co.*, 32 Fed. 320.

This case was before the Supreme Court in 158 U. S. 461, and although the lower court was reversed, the principle below stated was not questioned. In the Circuit Court it was said (p. 322):

> The date of the application, if it *described* the invention sufficiently, is conclusive evidence that the invention was made prior to such date. (Italics ours.)

In the case of *Automatic Weighing Machine Company* v. *Pneumatic Scale Corp.*, 166 Fed. 288, decided in the Circuit Court of Appeals for the First Circuit, Judge Colt said, *inter alia* (p. 293):

> the law is well settled that the date of a patented invention is at least as early as the date of the application, provided it sufficiently describes the invention to enable those skilled in the art to understand it; and we have found no decision in which this rule is questioned. "Patented inventions always date at least as early as the dates of the execution of the original application therefor, provided the original applications exhibit the inventions with the above-mentioned extent of sufficiency." Walker on Patents (4th Ed.) Sec. 70.

The court further cites and quotes from *Bates* v. *Coe*, 98 U. S. 31, and *Barnes Automatic Sprinkler Co.* v. *Walworth Mfg. Co.*, 60 Fed. 605, to the like effect, noting that the latter case was affirmed on appeal. The court also notes the *Barbed Wire Patent case*, 143 U. S. 275; *Miller* v. *Eagle Mfg. Co.*, 151 U. S. 186; and *Westinghouse* v. *Chartiers Valley Gas Co.*, 43 Fed. 582, as supporting its contention.

But if a claim, which is a mere *incident* and part of a complete antecedent disclosure may be so taken, should not the disclosure itself of the thing—on which disclosure a readable claim in another patent is later based—be equally well taken from its filing date as an anticipation of the later claim for a *feature* or perhaps limited portion of the thing before disclosed? In either case it makes no difference that it may not have been published; that is to say, given to the public or laid open to the public scrutiny until later.

It is difficult to see in what respect the mere *claiming* a *monopoly* of a thing is any more an evidence of prior *knowledge* of the invention than a full but unclaimed disclosure and dedication of the thing.

We repeat that the object of a claim is to place metes and bounds about the *monopoly* of a part or the whole of the thing disclosed. It does not change the *characteristics* of or enlarge or reduce the disclosure itself, for the latter may be much more extensive than the former; nor does it do away with the *fact* of the disclosure nor affect its *date* whether or not made by another than the claimant. An

applicant may be unable to legally claim all of his disclosure because the unclaimed portion may be known, which disclosure, if he could so claim it, would unquestionably be good as of the filing date as proving his prior knowledge. Why, then, should not the rest of the unclaimed disclosure be equally good as of the filing date, merely to prove such knowledge?

If, when a patent application claims less than its whole disclosure, the unclaimed portion is deemed to be old and known; it would be a strange inconsistency to maintain that a later application by another having claims readable upon the disclosure of the first application, would be invalid as to the part claimed in the first (because as to that, the earlier filing date controls) and be valid as to the part disclosed as known but not claimed. Yet that is the logical and necessary outcome of the respondent's argument and the decision of the court below.

III

That which is disclosed but not claimed, is abandoned or dedicated to the public

When an inventor discloses but does not claim an invention in his application, that disclosure is a dedication to the public of everything so disclosed but not claimed, *besides* being an indication of its existence at the time of disclosure. And it may be shown to have existed before that disclosure in the application.

Among the many decisions which are the authority for this statement, which is believed to be too well established to require argument, are the following from this Court:

Keystone Bridge Co. v. *Phœnix Iron Co.*, 95 U. S. 274, 279.

Miller v. *Brass Co.*, 104 U. S. 350, 352.

Mahn v. *Harwood*, 112 U. S. 354, 361.

McClain v. *Ortmayer*, 141 U. S. 419, 423.

Underwood v. *Gerber*, 149 U. S. 224, 231.

Deering v. *Winona Harvester Works*, 155 U. S. 286, 296.

Walker on Patents, 5th Ed., pp. 221 and 251.

Ide v. *Trorlicht, Duncker & Renard Carpet Co.*, 115 Fed. 137, 147.

We contend that the *dedication* or gift is complete and effective *when the application containing it as an unclaimed disclosure is filed, unless* reclaimed or withdrawn within reasonable time by a reissue or amendment claiming it.

Can it be annulled or the gift be rendered abortive through the delays that may occur in the publication of the patent containing the dedication, through no fault of the donor?

Can it be taken away from the public at the will of a later applicant who files his application and claim later than that of him who makes the dedication, even if this patent should issue before that of the real first inventor and dedicator?

And yet, if a later applicant (whose patent, claiming the disclosure as his own, issues later or even earlier) is permitted to monopolize it, the annulment

of the dedication and a misappropriation of the gift is a consequence; and so, not only is the public defrauded in the loss of that which was given it, but the later patentee gets a *monopoly* of something that he did not in fact originate. The mere issue of a patent (doubtless by mistake) on a later application claiming something already dedicated to the public should not be permitted to take from the public that which is already, as it were, held in trust for it by the Patent Office by virtue of the prior disclosure and dedication.

Under our law no one is entitled to a patent unless he has given to the public something that the public has not had before. If some one has been before him in giving by actual or constructive dedication that which he assumes to have invented, he is unable to confer upon the public any consideration for the grant of a patent, which is only the right to exclude from the monopoly. From that which already belongs to it, the public can not be excluded.

The result of dedication by failure to claim is to eventually open the door to everyone to freely use, *but not to exclude others from using* the thing left unclaimed or dedicated. As to when the gift took place, an analogy may be found in the gift of a statue or a building; the unveiling of the one or the dedication exercises of the other does not determine or change the time of the actual gift of the thing unveiled or dedicated.

The act of dedication of an invention, evidenced by the making of a disclosure without claim, pre-

supposes the existence of the thing dedicated at the time of dedication, that is, the filing of the application, not merely at the time of notification of the dedication—that is, of the issue of the patent.

That the date when the public is enabled to utilize the gift may not coincide with the date of the gift does not destroy the gift nor change the fact of it nor the date of donation, nor give another the right in the meantime to appropriate the gift, as would be the case of claiming in a later patent the thing previously given in an application containing a disclosure without claim.

The Patent Office is merely a trustee for the public, holding the instrument of dedication (which is the application containing the unclaimed disclosure) during the pendency of the issuance of the patent. When the patent issues, the public is enabled to fully appropriate the previously made donation which has been in the meantime held in trust for it.

Whether or not the public utilizes or even accepts the gift is beside the point and can not alter the *fact* of the gift nor its date.

So soon as the *patent issues* it merely becomes available *evidence* of the previous act of dedication; and of the prior knowledge of the thing dedicated; but the *fact* of the prior knowledge and the prior dedication is not affected by the date of publication of the patent, both facts necessarily dating at least from the time of the filing of the application setting them out.

It must not be forgotten that we are not dealing with a prior publication or patent, nor with a prior

public use of the invention, which are entirely separate grounds of invalidity; but we are considering an equally vital ground of invalidity, that is the *knowledge* of the thing by the public and its right to it—the "public" being a single person other than the assumed inventor—which *knowledge* deprives the assumed inventor of the essential characteristic of being the *first* inventor of something not before known.

In *McClain* v. *Ortmayer*, 141 U. S. 419 at p. 423, this Court said:

> Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public.

Underwood v. *Gerber*, 149 U. S. 224, 230, is also authority for this proposition. It quotes from *Miller* v. *Brass Co.*, 104 U. S. 350, 352, as saying:

> The claim of a specific device or combination, and an omission to claim other devices or combinations apparent on the face of the patent, are, in law, a dedication to the public of that which is not claimed. It is a declara- that that which is not claimed is either not the patentee's invention, or, if his, he dedicates it to the public.

Also from *Mahn* v. *Harwood*, 112 U. S. 354, 360, 361, cited *supra* (p. 16).

In the various cases where the question of who was the first inventor arose we believe it has been almost invariably true that the invention was determined by

the disclosure in the specification and drawings of the application as and when filed; and that where reference has been made in the opinions to "claims" it has been in order to show that the construction placed upon that disclosure is *confirmed* by the specific language of that crystallization of the part of the disclosure sought to be monopolized. This we believe to be essentially what happened in the case of *Sundh Electric Co.* v. *Interborough Rapid Transit Co.*, (2nd Circ.) 198 Fed. 94, decided by Judge Lacombe; for, among other reasons, he cites *Diamond Drill & Machine Co.* v. *Kelly Brothers*, 120 Fed. 295, which distinctly and unqualifiedly says on page 298:

> On the other hand, there can be no question as to the existence of the Henry M. Jackson machine as early as July 16, 1896, when he applied for his first patent, for the diagrams which accompanied the application show it exactly as it now is, except that the jaws are V shaped instead of being serrated. *No claim was made* for the separate operation of the rolls and jaws, *but that is not material.* It was a feature of the machine, and that is enough for our present purposes. (Italics ours.)

In the *Sundh case*, furthermore, Judge Lacombe held certain claims of the earlier issued patent invalid, because that patentee was not the first inventor in view of the *disclosure* of a later patentee whose application was first filed, but which did not, as a matter of fact, *claim* the subject matter of the claims held to be invalid.

IV

Analogy of interference proceeding in the Patent Office, and its long-established practice of considering an earlier disclosure prima facie evidence of ealier invention

In an interference proceeding in the Patent Office, the earliest applicant is considered to be *prima facie* the first inventor, and proof of earlier conception and diligence in reducing to practice is required of a later applicant to overcome the presumption in favor of the first.

This rule has been long established in the Patent Office and has received the approval of the courts. And a claim may be made at any time during the proceeding if there is a sufficient disclosure in the original application.

> *Westinghouse E. & Mfg. Co.* v. *Metropolitan E. Mfg. Co.*, 290 F. 661 at 665.

If such claim prevails it dates back at least to the filing date of the original disclosure, which is rightly assumed to be *prima facie* the date of the invention.

It is difficult to see, then, how a *claim* for an invention, which can only depend upon a disclosure, may be evidence of a prior invention, and date from the filing date of the application as such, unless the disclosure on which the claim is based, and which necessarily shows the thing claimed, is equally evidence of such prior invention or knowledge, as of the date of disclosure.

In the instant case if an interference had been declared between Clifford and Whitford, and Clifford

had made the claim which his disclosure shows he could have done, he would, so far as filing dates show, have been granted the patent as the first inventor. That an interference in fact existed is clear from the admissions. That an interference was not declared, and Clifford given an opportunity to establish his priority of claim as well as of disclosure is no fault of his; and it is submitted that his filing date is to be taken now as proof of his prior knowledge of the invention then disclosed, with as much force as it would have been had the interference been actually declared; not for the purpose of securing to him the monopoly, but to *establish the fact of his prior knowledge.*

Furthermore the custom of the Patent Office for many years has been to give a patent an effective date as of its application for everything disclosed in it whether claimed or not. And while it is true that the Office does not consider a mere application that has been withdrawn or finally abandoned and never issued, an anticipation *as such* of a later application, yet it does, under rule 75, require an applicant who is rejected on a patent, the application of which discloses but does not claim the invention, to show priority to the filing date of the cited patent in order to prevail.

> *Ex parte Hammond and Hammond*, 301 O. G. 1051; 1922 C. D. 15.

That is to say, the Patent Office has, for so long a period as thirty-six years, since the rule was adopted in 1898, held that such an unclaimed disclosure is

prima facie evidence of *prior knowledge* at the date of filing of the thing sought to be covered by the later application, which is sufficient to bar a subsequent patent for it. This practice has been upheld by the Court of Appeals of the District of Columbia and by various Courts of Appeals of the different circuits.

In the case of *In re Millett*, 18 App. D. C., 186 (1901 C. D., 410, at 411), the Court of Appeals, D. C., said (p. 188):

> The application was filed on February 17, 1900. It was rejected by the primary examiner in an elaborate opinion on reference to a patent issued to one Frederick Lane on February 20, 1900, *three days after the filing of the application of the appellants, but which patent had been applied for by Lane upwards of two years before.* It was contended by the appellants that their application should not be rejected by reference to a patent issued after the filing of their application, in which their alleged invention, if shown at all, was not claimed, and only appeared in the drawing annexed to the patent; and further that this drawing did not show the invention of the appellants. This contention the primary examiner did not sustain; and his ruling was affirmed on appeal both by the board of examiners-in-chief and the Commissioner of Patents. And from the decision of the Commissioner the case has been brought to this court by appeal.
>
> With reference to the first branch of the contention of the appellants, we are satisfied that the tribunals of the Patent Office were entirely

right in the conclusion reached by them. If the drawings annexed to the Lane patent fully and satisfactorily show the device claimed by the appellants, and if these drawings were the same that were filed with Lane's application in the first instance—and we must assume that they were the same until the contrary is made to appear—it is very plain that they show anticipation of the invention of the appellants. It is of no consequence that Lane does not include this device among the *claims* of his own invention. His failure so to do simply implies either that he *abandoned it to the public, or that he regarded it as already well known to the art.* **It does not help the appellants in any manner that he does not claim it.**

It is not the fact that a patent was issued to Lane upon his application which constitutes anticipation in this case. Although that patent was issued in so short a time after the application of the appellants that, in view of the usual and necessary course of business in the Patent Office, we might fairly assume that the facts which justified its issue had been satisfactorily shown long before the advent of the appellants to the Office, yet the patent of itself would not be sufficient to show anticipation by Lane of the device of the appellants. *But the fact which shows such anticipation is the state of the art at the time as evidenced by the drawings and specifications of Lane's application.* For it is the condition of the art at the time at which an alleged invention is made, and not the existence of a patent, which in this connection is no more than *evidence* of the state of the art,

> which determines whether an invention claimed is actually an invention or not under the patent law. **And this state of the art may be shown by a printed book, a periodical publication, a newspaper, anything in fact which can be regarded in law as reasonably sufficient proof of the fact. This we understand to be the rule deduced from reason and the authorities.** (Emphasis ours.)

We believe this to enunciate the correct principle, in harmony with both law and logic. This takes us back to the provision in Section 4886 R. S., that a valid patent can issue only for what is "New" and not before "Known," and the language of this Court in *Bate Refrigerating Co.* v. *Sulzberger*, 157 U. S. 1, 34 seems entirely in point here, although referring to the interpretation of section 4887:

> If section 4887 of the Revised Statutes is so worded as to express clearly the intention of Congress, the court must give effect to that intention. But even if the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting either one of two constructions; this court, without departing from sound principle, may well adopt that construction which is in harmony with the *settled practice of the executive branch of the government, and with the course of judicial decisions in the Circuit Courts of the United States* * * * . (Italics ours.)

V

The filing of an allowable application is a constructive reduction to practice and evidences a completed invention, even if no actual machine or even model is made

That an allowable application duly filed constitutes for all purposes of the patent laws an actual reduction to practice or is equivalent thereto, has been consistently held by the Patent Office, the Court of Appeals of the District of Columbia, the various Circuit Courts of Appeals; and that it is approved by this Court it is confidently asserted the following cases will show:

> *Automatic Weighing Machine Co.* v. *Pneumatic Scale Corp.* (1st Cir.), 166 Fed. 288.
>
> *Computing Scale Co.* v. *Standard Computing Scale Co., Ltd.* (6th Cir.), 195 Fed. 508.
>
> *Sundh Electric Co.* v. *Interborough Rapid Transit Co.* (2d Cir.), 198 Fed. 94.
>
> *Westinghouse Machine Co.* v. *General Electric Co.*, 199 Fed. 907; affirmed (2d Cir.) 207 Fed. 75.
>
> *Telephone Cases*, 126 U. S., 536.

In the *Sundh case, supra,* Judge Lacombe said (p. 97):

> It is further settled by authority that, even though he may not build a machine or a model, he reduces his invention to practice when he files with the Patent Office an application containing specifications so careful, exact, and complete that a man skilled in the art can, by following their instructions, produce a machine which will meet the descrip-

tion and produce the results which the application asserts it will. *Bates* v. *Coe*, 98 U. S. 31, 25 L. Ed. 68; *Porter* v. *Louden*, 23 Wash. Law Rep. 689.

VI

That which is disclosed in the application for a patent, but not claimed, is presumed to have been known before the applicant's act of invention as set out in the limitation of his claim; this presumption must then necessarily become a conclusion as to any later patent; and this Court has consistently held that no inventor is a true and first inventor, and hence entitled to a patent, if the thing patented or sought to be patented was known to any other before his application.

In the case of *Mahn* v. *Harwood*, 112 U. S. 354, 361, this Court said:

> The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but *was known and used before he made his invention*. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the *evidence* of this. (Italics ours.)

We take this to mean that the disclosure of an idea in the description of an application for a patent, when not claimed by the applicant, is presumptive indication that that idea was *known* and used *before* his own claimed invention—that is to say, before the filing of his application. But whether so or not, it necessarily evidences his own knowledge of the thing disclosed, at least at the time of his application. If it was so known and used before his application it can not be the subject of a new

inventive act by himself, and certainly not by any *later* inventor, for it was already in existence, and hence can not be thereafter created.

The patent, when issued, containing the unclaimed disclosure is *evidence* proving this, but the *fact* of the prior existence of the old idea remains the same even if the patent which evidences it never issued. The issued patent merely makes the fact *available* in and as *evidence*, and as such evidence it indicates that when the *application was filed the fact was known to others.* That is to say, that it was known to the applicant making the disclosure; to the attorney if there was one who acted for the applicant; to the officials of the Patent Office acting upon the application, and presumptively to *others of the general public even before* his *application was filed;* the making of the disclosure in the application even if without the claims of monopoly for it—being presumptive evidence of that fact, and the issue of the patent later *making that evidence available in form of proof.* And this disclosure need not be such a one as constitutes a perfected and complete embodiment of the idea in detail.

In brief, therefore, since an allowable application, especially if that application afterwards ripens into a patent, is not an abandonment in the sense of a thing lost or forsaken, and more especially if that application by disclosure and failure to claim is either evidence that the thing was before known or is actually a dedication to the public—the thing

therein disclosed can not, under the ruling of the executive branch of the Government, the ordinary interpretation of the words of the statute, and the decisions of the courts, be considered "*new*" or "*unknown*" so as to sustain a later patent for the thing so disclosed, issuing as a consequence of and based upon a later application. (*Bate Refrigerating Co.* v. *Sulzberger, supra*, page 25.)

We repeat this is not a question of which of two rival inventors is entitled to a patent. *It is solely a question of whether or not one of them is entitled to a patent* **at all,** *because not having complied with the statutory requirements of being the* **first** *inventor of something not before* **known.**

We can not harmonize the great mass of decisions with the contention that an idea, though fully described in an application, is not "invented" until claimed, and that the formulation of a claim, although it does not in fact add anything to the knowledge of the idea already existing (although it may crystallize a portion of it in precise language), yet works some mysterious change or charm so as to make that legally known for the first time which was in fact actually known long before. For the *statute does not say "not before 'invented'"* or "*claimed,*" but "not before '*known.*'" The object of the statute is to reward a creator of that which was not before; if the real creator has waived his reward by failure to claim his creation, that should not furnish basis for giving the reward to one who is not in fact the creator. That which exists can not again be created.

This Court has said in the *Telephone cases*, 126 U. S. 1, at page 536:

> The law does not require that a discoverer or inventor, in order to get a patent for a process, must have succeeded in bringing his art to the highest degree of perfection. It is enough if he describes his method with sufficient clearness and precision to enable those skilled in the matter to understand what the process is, and if he points out some practicable way of putting it into operation.

The same rule, of course, applies to a patent for a machine. *Sundh Electric Co.* v. *Interborough Rapid Transit Co.*, 198 Fed. 94.

It can not be doubted that "a practicable way of putting it into operation" may be adequately disclosed in a written description, especially when taken in connection with a drawing of a patent, even if it be not crystallized in the form of a claim for a specific structure. *McClain* v. *Ortmayer, supra.*

It is equally clear that the mere subsequent *issuance of a patent in printed form* containing a specific claim of monopoly does not change the character or completeness of an unclaimed disclosure in the application on which the patent is based. It gives no greater or clearer information; it does not constitute more conclusive proof of the fact of prior existence of knowledge of the idea disclosed; it merely makes the patent itself *evidence* of the existence of that knowledge as of its date, as a *patent* or *printed publication;* its value as evidence of presumptive prior knowledge of the unclaimed dis-

closure by another than a later applicant is unchanged and is not increased by its publication, and that prior knowledge dates at least from the filing date when the disclosure was made—that is, its presumptive reduction to practice by the filing of the application.

The Corn Planter Patent case (*Brown* v. *Guild*), (23 Wall. 90 U. S. 181), (Post, page 41), clearly shows that even a rejected and abandoned application may have "a bearing on the question of prior invention or discovery."

And in *Northwestern Fire Extinguisher Co.* v. *Philadelphia Fire Extinguisher Co.*, 1 Bann. & Ard. 177, Judge McKennan said, at p. 186:

> But it does not follow that *rejected* specifications and drawings are, under all circumstances, inadmissible as evidence. By themselves they are inconsequential, but when the inventor's idea is perfected by a practical adaptation of it, in the form of mechanism, *they are valuable guides in ascertaining the date of the invention*, the design of the inventor, and the principle, intended functions, and mode of operation of his mechanism, and they must, therefore, necessarily be considered in connection with it. (Italics ours.)

So since the mere *filing* of an allowable application clearly disclosing an operative device is a reduction to practice and pertinent on all questions of novelty, it is a consequence that when a patent based thereon actually issues—thus proving its allowability—the application therefor, properly presented and proved,

is competent to establish the date of the invention and the existence of knowledge of it as of the date of filing.

This must be the case whether the patent be the basis of a suit for infringement or one relied upon in defense of such suit. In the latter case, of course, it must be properly pleaded as showing such prior *knowledge* and invention and not as a *patent* or *printed publication*, which, of course, it is not.

In *Barnes Automatic Sprinkler Co.* v. *Walworth Mfg. Co.*, 60 Fed. 605, at 606, the Circuit Court of Appeals for the Seventh Circuit, referring to the opinion of the court below (51 Fed. 88) holding—

> The public notice of the device must be carried back to the date of filing the application,

harmonizes that statement with the text of *Bates* v. *Coe, supra*, and says:

> This rule, it is clear, can be applicable only to the one defense "that the improvement *had been patented or described in some printed publication* prior to the supposed invention." In order to come under the provision of the statute which authorizes *that defense* the patent or publication relied on must be prior in point of time to the patent in suit. And it is perhaps true in respect to any form of defense that if a patent is referred to simply by number and date, without averment of earlier invention and use, *or of the date of the application upon which it was granted*, evidence of those particulars would not be competent, because not within the issue. *But when the*

answer is framed, like this one, to show, not a prior patent or publication, but that the grantee of the patent in suit was not, and that the patentee of a patent of later date, issued upon an earlier application, was the first inventor, it is an anomalous proposition that the fact which the statute declares to be a defense can not be established by any proof which, under the ordinary rules of evidence, is admissible. In the case of *Western Electric Co.* v. *Sperry Electric Co.*, 9 U. S. App. —, 8 C. C. A. 129; 59 Fed. 295, where this court held that, when two patents for one invention had been issued, the owner of the second may sue the owner of the first, or those operating under it, without having obtained relief under Section 4918 of the Federal Revised Statutes, it is said:

"Whether one patentee or the other, when he makes or uses the invention, is an infringer or trespasser *depends upon the inquiry whether the one or the other was the first inventor, and not whether he was the first to obtain a patent;* and this inquiry may as well be made in the ordinary suit in equity as in the proceeding provided by the statute."

If the parties in that case had been reversed, and the Western Electric Company has been made respondent to a bill by the Sperry Electric Company, either in a suit of the ordinary form in equity or under the statute, its defense would have been that its patent, though later in date, *had been granted upon the earlier application to the first inventor;* and yet, if the rule quoted is to have the broad application contended for, the defense could not

> have been admitted, and the other party would necessarily have prevailed. *The decision in Bates* v. *Coe involves no such absurdity as that in respect to a single dispute a party may have a cause of action against his adversary, and yet, if made a respondent, have no defense. It may be granted, in the very terms of that opinion, "that the patent or publication can only have the effect as evidence that is given the same by the statute," and yet, when the issue of priority of invention is presented, other facts necessary or proper for the determination of that issue may be proved.* (Italics ours.)

In the court below (51 Fed. 88 at 90, 91), in the *Barnes* case just cited the trial Judge said:

> While the Talcott patent granted January 31, 1882, but for which application was filed in the Patent Office April 8, 1879—and the public notice of the device must be carried back to the date of filing the *application*—clearly shows and describes, etc.

And again:

> I am therefore very clear that the Talcott patent of January 31, 1882, which relates back to the time it was *applied* for in April, 1879, clearly anticipates the fourth and fifth claims of the complainant's patent. (Italics ours.)

It is to be noted that this ruling was upheld by the Circuit Court of Appeals, and that it was made in a suit where the disclosed invention of a patent of a later date and number but earlier application was set up as a matter of defense.

Also in *Westinghouse* v. *Chartiers Valley Gas Co.*, 43 Fed. 582, which was a case where suit was brought on a patent, and an application filed earlier than the application of the patent in suit was introduced to show that the patentee was not the original and first inventor, and that his patent was not for a new invention, the court said (page 588):

> The plaintiffs contend that the Nicholson application is inadmissible as evidence. Is this a sound position? That a rejected or withdrawn application is not a *prior publication*, within the meaning of the statute, nor of itself a bar to a patent to an independent inventor, is settled. *Lyman V. & R. Co.* v. *Lalor*, 12 Blatchf. 303; *Northwestern Fire Ex. Co.* v. *Philadelphia Fire Ex. Co.*, 6 O. G. 34; *The Corn Planter Patent*, 23 Wall. 181. *But it by no means follows that Nicholson's application is not to be received for any purpose.* It has neither been withdrawn nor rejected. Abandonment by him can not be alleged. In the interference proceeding he was awarded priority of invention over Verner. That he was prior to Verner was indisputable under the proofs before the court. The utility of the device in question was demonstrated. It would then be most extraordinary if Nicholson's application could not be shown as affecting Verner's title to the monopoly here set up against the defendant and the public. I think the cases of *Northwestern Fire Ex. Co.* v. *Philadelphia Fire Ex. Co.*, *supra*, and the *Corn Planter Patent*, *supra*, *are direct authorities to show that the Nicholson application*

> *is competent* evidence as bearing on the question whether Verner was in fact the original and first inventor of the thing alleged to be within the first and second claims of his patent. (Italics ours.)

The case of *Pennock* v. *Dialogue*, 2 Peters (27 U.S.), 1, at p. 23, contains a statement that seems applicable to the point in issue. This Court, by Justice Story, said, referring to the statute:

> It gives the right to the first and true inventor, and to him only; if *known* or used, before his supposed discovery, he is not the first, although he may be a true inventor * * *. (Italics ours.)

It will be observed that it is not necessary that the invention shall have been actually *used* before the later alleged invention; the knowledge is sufficient; the alternative form is expressed, *known, or* used.

If, therefore, the idea of means was known (and that fact is made apparent by a prior appiication) that knowledge, even if merely disclosed and unclaimed (hence indeed abandoned so far as the claim of monopoly is concerned, in the sense of dedicated to the public), is none the less a prior *knowledge*. A patent which issues after another patent (but was first applied for) and contains an unclaimed disclosure of subject matter claimed in the later patent, clearly shows on its face that the subject matter disclosed was known to another at the time of the filing date of the earlier appication; it is the date of the knowledge that controls, not the date when the knowledge is or may be *proved* in evidence by introduction of the application of the patent containing the disclosure.

If by disclosure in an application, without claim, an inventor abandons or dedicates his invention to the public (and this is well settled, as we have shown above, page 15), that abandonment or dedication occurred at the time of the disclosure—that is to say, when this application was filed—the fact of abandonment or dedication presupposes the existence of the thing abandoned or dedicated at the time. The later publication of the disclosure in an issued patent is merely evidence of the fact. (*Mahn* v. *Harwood*, *supra*, p. 27.)

In *Gayler* v. *Wilder*, 10 How. (51 U.S.) 476, the Court held, in effect, that an abandonment or forsaking which resulted in *permanent loss* to the public of an idea or structure, left the field open to a subsequent original inventor of the same idea. Here, however, the Court said (p. 498):

> Yet, if it (the invention) was the same with Fitzgerald's (the subsequent patentee), the latter would not upon such grounds be entitled to a patent, *provided Connor's safe and its mode of construction were still in the memory of Connor before they were recalled by Fitzgerald's patent.* (Quoted in *Coffin* v. *Ogden*, 18 Wall. 120, at 125.) (Italics and parentheses ours.)

In other words, the loss and disappearance of an invention from the memory of everyone must have been complete, or else that invention will become a bar to a subsequent patent. But this is very different from a deliberate abandonment by dedication by disclosure to the public, in an application disclosing

the invention containing claims based thereon, which afterward mature into a patent. Indeed, the court proceeds to say that under the circumstances of the case then at issue—

> There was no existing and living knowledge of this improvement, or of its former use, at the time he (the patentee) made the discovery.

Of course, a disclosure in a patent application ultimately issuing as a patent, indicates an existing and living knowledge of the thing disclosed, which upon issue becomes general. So it seems to us that this case supports our contention that an actual prior invention, even, and especially if abandoned, in the sense of dedicated to the public by an unclaimed disclosure in a patent application afterwards issuing, is a bar—not as a prior *patent*, but as showing existing prior *knowledge*—to a subsequent patent for the same idea of means.

In this case also the dissenting opinions of Justices McLean and Daniel go even farther than we go, in this respect that they maintained that mere prior knowledge, *whether forgotten or not*, is a bar to a subsequent patent for the same thing on the ground that a thing once known can not thereafter be invented.

In *Seymour* v. *Osborne*, 11 Wall. (78 U. S.) 516, at p. 552, and in *Whitely* v. *Swayne*, 7 Wall. (74 U. S.) 685, at p. 687, the Court held:

> For he is the first inventor, and entitled to the patent, who, being an original discoverer, has first perfected and adapted the invention to actual use.

It is repeated that a full disclosure in an allowable application, in such form and completeness as would allow one skilled in the art to actually construct the machine disclosed, is a reduction to practice of the invention as of the date of filing the application. (See *Telephone cases, supra*, p. 26.) That an idea or structure may be disclosed in such detail by a specification and drawing as to enable one skilled in the art to construct it, without its being set within the bounds of a "claim," seems self-evident.

The one, therefore, who first thus sets it forth is, under the cases cited, clearly the first inventor, and if instead of constructively dedicating it to the public by disclosure without claim he had claimed it, it is to be presumed that the claim would have been allowed unless, indeed, it were so old and well known as to present no novelty or invention. But in that case it would even more positively indicate that anyone filing a later application for that thing so disclosed could not be the first inventor of that which was known before.

That only a part of the disclosure is monopolized by a specific claim does not render the rest any the less a perfected invention (if the disclosure is sufficiently clear to those skilled in the art), even if the invention be not brought to the highest state of perfection; nor is its originator any the less the first inventor. If this be true, no later inventor can be the "first" inventor, and entitled to a patent. A subsequently issued patent on the first inventor's

application containing the disclosure, is evidence of that prior invention, and establishes the fact—not of a prior publication, for it may have been later published, but of a preexisting *knowledge* of the thing later published.

In *Bates* v. *Coe*, 98 U. S. 31, the issue turned on the sufficiency of a prior *patent* as an anticipation in its capacity as a *prior patent* or *printed publication*, and while the defense that the "complainant is not the original and first inventor" was pleaded, yet the defense of such prior invention or use did not include the offer of sufficiently convincing evidence to support it, and the Court really decided the case on the defense of prior *patent* or *printed publication*, holding that as to that defense it was not proved so as to overcome the *prima facie* presumption of the later patent's validity.

It certainly is straining the language of this decision to construe it into a statement that the defense of prior *knowledge* of an invention which rests upon a disclosure (unclaimed) in an application for patent afterwards issued, is not sustained by proof that the application containing that disclosure was filed more than two years before the filing date of the patent alleged to be infringed.

The language of the decision leaves us entirely free to maintain that if the *pleading* in that case had specified prior *knowledge* by another as shown by a disclosure in a complete and allowable application duly filed, even if unclaimed, and had proved the allegation by duly offering the application showing such

disclosure in evidence, that defense would have been sustained. In other words, the statement (pp. 33, 34):

> Neither the defendant in an action at law nor a respondent in an equity suit can be permitted to prove that the invention described in the prior patent, or the invention described in the printed publication, was made prior to the date of such patent or printed publication, for the reason that the *patent* or *publication* can only have the effect as evidence that is given to the same by the act of Congress. (Italics ours.)

merely indicates that the Court used this language with reference only to the defense of prior *patent* or *publication;* the question of the sufficiency of a disclosure in a prior application as evidence of prior knowledge on the part of others, not having been raised and not having been considered by the Court.

The early case of the *Corn Planter Patent* (*Brown* v. *Guild*), 23 Wall. (90 U. S.) 181, is of especial interest.

In this case a device had been experimented with, and, so far as further actual use, had been abandoned and lost. Moreover, as the Court found (p. 210):

> It may have presented one or two ideas in advance of other machines, but it can hardly be said to anticipate the machine which we have described as Brown's.

That is to say, *it did not disclose the same invention.* Further, the application for patent on the device had been voluntarily withdrawn or proved to have been abandoned from further prosecution. So

the device did not only not disclose the same idea as the patent which it was sought to overthrow by it, but the device itself was abandoned or forsaken and the application for a patent therefor voluntarily withdrawn and never renewed.

Clearly, here we have the case of a mere incomplete abandoned experiment not even disclosing the same idea as that of the patent it was sought to anticipate by it, and which never rose to the dignity of invention. It naturally could not be considered an anticipation, even as a matter of prior knowledge and use.

But even here the Court distinguished between what may constitute an anticipation as a prior *patent* or *printed* publication and an anticipation because of prior *knowledge*, and says (p. 211):

> But a mere application for a patent is not mentioned as *such a bar* (a patent or a "description in a printed publication"). *It can* only have a bearing on the question of prior invention or discovery. (Italics and parentheses ours.)

By this language the Court, by limiting the bearing of the application to the exception stated, clearly gives basis for the inference that an application making a sufficient disclosure of an anticipating nature *could* have a bearing on the question of prior invention or discovery—that is, because of prior knowledge and disclosure through a mere application for patent, even though it never issued.

Moreover, as we have said in this case, the patent application itself was abandoned from further prose-

cution and forsaken, which is a very different situation from that where disclosure is made in an application which *afterward matures into a patent*, even though the disclosure is not fully claimed, and is so constructively dedicated to the public.

On the question of what is and what is not an abandoned experiment a moment's digression may here be permitted to cite the case of *Buser* v. *Novelty Tufting Machine Co.* (C. C. A., 6th Cir.), 151 Fed. 478, 492.

Here, after discussion of many cases, the court concluded that there is a decided difference between an "abandoned *experiment*," which *is* not a valid instance of anticipatory prior knowledge or use, and an abandoned *invention*, which *is* as much an anticipation which negatives novelty in a later patent as if it had not been abandoned, citing *Gayler* v. *Wilder*, 10 How. (51 U. S.) 481, 496, as authority for the proposition. See also Walker on Patents, 5th Ed., Sec. 63, p. 221, and cases cited.

The principle is that an experiment is merely embryonic and incomplete until reduced to practice in a working device, or an allowable (not necessarily claimed) patent application. But when so reduced to practice it is immaterial how little it may have been known or used; quoting from *Coffin* v. *Ogden*, 18 Wall. (85 U. S.) 120, at 124:

> The prior *knowledge* and use by a single person is sufficient. The number is immaterial. (Italics ours.)

Certainly, an invention which has been fully described and illustrated in an allowable application, is therefore not a mere experiment; and where the patent has subsequently issued (even where the part disclosed is not claimed) it can not be said to be an "abandoned" or "forgotten invention" even if not thereafter actually utilized.

It follows, therefore, under the cases cited, that such a disclosed invention constitutes an anticipation (as showing prior knowledge) of any later application, and further must constitute such anticipation from the date when it became complete; but as the filing of an application is a constructive reduction to practice, the invention becomes complete as of the date of filing; hence the anticipation or prior knowledge is established as of that date. It follows further that under the ruling of *Mahn* v. *Harwood, supra*, the patent itself when issued is *evidence* of that fact.

It is true that a mere written description of an idea or device illustrated by drawings is not a "publication" which will of itself act as a bar to a later application for patent (though if embodied in an operative structure it may be evidence of prior knowledge in another: *Loom Co.* v. *Higgins*, 105 U. S. 580 at 594). But when published in a patent it becomes as much open or given to the public as a *claimed* disclosure. If the latter acts as a bar from its filing date—even though issued later—why should not the unclaimed disclosure in the same published patent that is equally open to the public? In what respect does the *claiming* add to public knowledge or

enlarge the disclosure? The unclaimed portion is not an abandoned experiment—it is a constructive reduction to practice. An actual practical machine once made and known to others is a bar even if abandoned, under the decisions, and acts from its date as such—how much more a disclosure in a patent subsequently issued and hence not abandoned?

Under the statute for the third defense a mere printed publication (not a patent), which contains no claim but clearly discloses an invention in such form that one skilled in the art can construct it, is a valid anticipation of a later patent, if early enough. From this it is evident that it is not the crystallization of the inventive thought into the expression of a "*claim*" or the bounding a portion of it in the terms of a "claim" that makes a prior patent or publication an anticipation or reference to show the preexistence of knowledge of the thing invented, *but it is the sufficient disclosure of the subject matter which may or may not be actually bounded by a claim.*

By analogy an equal disclosure sufficiently proven to have existed before, should satisfy the requirements to establish the fourth defense of prior *knowledge.* If Clifford had testified that the structure disclosed in the application was known to him at the time of the filing, and had produced the structure as confirmatory evidence, and it was not "proved" to have been abandoned, in the sense of forsaken, that testimony should have established the defense of prior knowledge in view of *Gayler* v. *Wilder, supra.*

It is difficult to see how the application itself, which is in itself evidence both of the thing known and the date of the knowledge, is not as good or better evidence than the personal recollection of Clifford.

In the *Barbed Wire case*, 143 U. S. 275, this Court clearly concedes by inference that an unpatented device, if clearly disclosing the alleged invention of a later patent, may, if the proof be clear, satisfactory, and beyond a reasonable doubt, be a complete anticipation of a later patent, as showing that the thing patented existed and was known before, and hence that the patent was not for a *new* invention, *not before known*, and that therefore the patentee was not the first inventor.

Our comment on this case is that, as such is the law, what better proof of the preexistence of knowledge of an invention can be given than an application admittedly disclosing it, which, of course, speaks from its date of filing of the fact of its existence at that date?

If an unpatented device may be sufficient evidence of prior knowledge of an invention, a recorded disclosure though unclaimed—especially if, instead of being abandoned, it later materialized into a patent—is as good or better.

In the case at bar the identity of the inventions is conceded; the fact and date of the earlier disclosure are proved by the best possible evidence—that is, the production of the document itself verified by the Patent Office.

VII

Analogy of a reissued patent

A patent may be reissued to cover the invention actually disclosed but not adequately claimed in the original specification and drawings of an issued patent. When so reissued the date of invention of what is disclosed but not claimed remains the same as of the date of filing the original application containing the mere disclosure on all questions of novelty, even though then not adequately or properly claimed. *Grant* v. *Raymond*, 6 Peters (31 U. S.) 218, at 243.

Why, then, should not an unclaimed disclosure in an original application though not reissued be equally good as determinative of such questions of novelty?

VIII

Supreme Court cases clearly supporting petitioner's contention of the invalidity of a later patent when the invention is disclosed in an earlier application, even if not claimed

In *Brown* v. *Davis*, 116 U. S. 237, a patent to a later applicant was held to be limited, and, so far as it covered the device illustrated and described in a prior application (which was abandoned and never issued) could not lawfully have been granted, and therefore was invalid because anticipated by the prior application. The Court says (p. 250):

> In order to determine what construction ought to be given to the other claims of the reissue, it is necessary to consider an invention made by one Powers * * * in 1862, the

> invention of Davis being carried back only to September, 1866. * * * He (Powers) worked out a plan and made a model of it, and applied for a patent November 10, 1862. The patent was ordered to issue December 6, 1862, but was never issued. The reason is not stated. The specification filed states * * *. The method described and shown in the drawings is * * *. The description states * * *. The claim covers * * *, etc.

This invention was embodied in an actual device which worked perfectly, and the Court held that it was "a completed invention," and that in view of its disclosure the limitation and invalidity of the Davis claims were established. It is repeated that this patent never even issued, and it is to be noted that the Court constantly refers to the *disclosure* in an unissued patent as the ground for anticipation, and while an actual device was made, that fact merely confirms the fact of prior invention, since, as we have shown, the filing of the application was in itself a constructive reduction to practice, sufficient in itself to show prior knowledge of the invention and that it was not merely an abandoned and forsaken experiment, and so this Court evidently considered it.

In *Yale Lock Company* v. *Greenleaf*, 117 U. S. 554, at 557, a patent was held to be anticipated by a rejected or abandoned application, the specification of which disclosed the so-called invention of the patent, on the ground that what the patentee *thought* had never

been done before, had, as a matter of fact, been done by the device of the specification; that is to say, the patent was void because it was not for a **"new"** or not previously **"unknown"** invention, the fact of the prior knowledge being shown by the prior application, even though it had never passed to issue as a patent.

In *Pope Mfg. Co.* v. *Gormully Mfg. Co.* (No. 2), 144 U. S. 238, 244, the Court says:

> There was also a patent issued to one Smith upon the same day the Peters patent (the patent in suit) was issued, namely, November 20, 1877, but upon an *application* filed September 1, 1877, prior to Peters' application, and therefore, *anticipating* Peters' patent. (Italics and parenthesis ours.)

We submit that this case plainly and expressly recognizes the principle that a later patent may be anticipated by another *application* earlier filed. (The numbers of the two patents show which of the two patents was earlier granted—see *Underwood* v. *Gerber*, 37 Fed. 682, affirmed in 149 U. S. 224.)

That the device of the anticipating application was not entirely the same as that of the patent held to be anticipated by it, and so was not considered to invalidate it, is beside the point and does not detract from the plain pronouncement of the Court that the *application as such anticipated the patent*, and was, of course, effective as of its filing date.

In *Olin* v. *Timken*, 155 U. S. 141, this Court reversed a decision of the court below; and held a patent invalid, on the ground, among others, that the applica-

tion for it was subsequent to the invention by another, as shown in the specification and drawing of an application filed subsequently, but disclosing the invention, with evidence that it was made earlier.

The Court said, at p. 154:

> He (the earlier inventor) applied for a patent shortly after the allowance of the Timken patent (the patent in suit) and his application was rejected (that is, the claims were refused), but the specification and drawing of this application are given in the record, and show clearly the invention claimed in this suit. (Parentheses ours.)

Roberts v. *Ryer*, 1 Otto (91 U. S.) 150.

This is a case where a patent was held void because anticipated by a patent issued later but applied for earlier, *showing* but not *claiming* the same invention. On page 155—

> Such being the patent, we now proceed to consider the defense; which is, that the invention patented had been anticipated by Asel S. Lyman and others. Sanford, the patentee, does not carry his invention back of the summer of 1855 (issued Nov. 13, 1855), when, it perhaps sufficiently appears, his application was filed.
>
> On the 21st of September, 1854, Lyman filed his application for a patent for "a new and improved mode of cooling, drying, and disinfecting air for ventilators and refrigerators." * * *
>
> (P. 158). Lyman had conceived the idea of his invention as early as August 19, 1852, for

he then filed his caveat in the Patent Office. His ideas were, at that time, undoubtedly crude; but it is clear that he kept steadily at his work. * * *

As has been seen, Lyman, after having, as he thought, perfected his invention, applied for his patent September 21, 1854. Technical objections were made; and on the 19th of April, 1855, he withdrew his application. He, however, still kept up his correspondence with the department, vigorously pushing his claim. On the 28th of November, 1855, only 13 days after the grant of the patent to Sanford, he filed a new application, and, in doing so, distinctly connected it with the first. There certainly is no material difference between the old and the new. On the 25th of March, 1856, a patent was in due form issued to him.

Down to this time it is impossible to discover any material difference between the two patented inventions. Clearly Lyman was the oldest inventor, and his patent was consequently the best, although that of Sanford antedated his. His last application was rejected December 5th, because it had been anticipated by Sanford; but *afterwards the subject was reconsidered, and a patent issued to him.* * * *.

(P. 159.) Clearly, we think, therefore, the invention of Sanford was anticipated by Lyman; and his patent is, on that account, void. * * *

We think the evidence establishes, beyond all question, that Lyman (the first applicant but later patentee), and not Sanford, was the original and first inventor of all there is of this improvement. (Italics and parenthesis ours.)

The case of *Cochran* v. *Zimmerman*, 53 Fed. 801, while not a decision of this Court, is of interest as expressing what we believe to be the principle of the cases just cited, and because the opinion was rendered by Chief Justice Taft, then sitting as Circuit Judge.

This was a case of a reissued patent granted on July 10, 1888. The court held that it was void because anticipated, in that the same invention was disclosed (it does not appear that it was claimed) in a patent subsequently issued on August 28, 1888, but *applied* for on February 7, 1887; that is to say, five months before the application for the original patent on which the reissue was granted.

IX

The third and fourth defenses are separate and distinct, and much of the confusion and apparent diversity of decision is due to improper pleading thereunder, and the introduction of insufficient evidence to support the pleading

Much of the confusion seems to have arisen because of improper pleading—or failure of proof to support the pleading.

Of course if a patent which is later in date is cited against an earlier patent *as an anticipating patent*, in the effort to prove anticipation and invalidity of the earlier patent under the third defense—that is, of prior *patenting*—it will not avail, even though the application may disclose the same subject matter, because it manifestly is not an earlier issued patent;

but that the disclosure in an earlier application showing the same subject matter is, when the patent issues, available as evidence, showing conclusively the fact of the existence of prior *knowledge* of the subject matter, is another question—we think can not be denied, and is not denied either by this Court or by other courts than those of the Second and Seventh Circuits.

In most, if not all, of the cases in the lower courts, except those of the Second and Seventh Circuits referred to in the beginning of this brief, and certainly in this Court, this distinction is directly or inferentially recognized, and we find no instance other than those mentioned where the Court has refused consideration or denied the competency of a sufficiently disclosing prior application where properly pleaded as a ground for establishing the fourth defense.

In the case of *Sundh Electric Co.* v. *Interborough Rapid Transit Co., supra*, decided in the Circuit Court of Appeals for the Second Circuit, Judge Lacombe says, at page 96:

> The nature of the defense of prior art is succinctly expressed in section 4920, U. S. R. S., subdivision third:
>
> "That it (the device of the patent) has been patented or described in some printed publication prior to his (the patentee's) invention or discovery thereof, or more than two years prior to his application for a patent therefor."
>
> Ihlder's device was certainly not patented before Sundh's invention, which was com-

pleted by reduction to practice on the day the latter filed his application. Nor was Ihlder's application, although it completed his invention by reducing it to practice on the day such application was filed, a "publication" within the meaning of the statute, because it remained unpublished in the secret records of the Patent Office until after Sundh's application had been filed. The Ihlder patent, therefore, was no part of the prior art.

It is contended, however, that the court erred in not sustaining a separate defense based upon the Ihlder patent, viz; the defense enumerated in the fourth subdivision of Section 4920, U. S. Rev. Stat. (U. S. Comp. St., 1901, p. 3395):

"That (the patentee) was not the original and first inventor or discoverer of any material and substantial part of the thing invented."

This is a separate and distinct defense from the third one, and while evidence is not admissible to carry back the date of a later patent, by showing that application for it was filed earlier, *the fact that the person who took out such later patent was himself the original and first inventor of the invention in controversy earlier than the plaintiff may be proved, as any other fact is, by competent proof. Barnes Automatic Sprinkler Company* v. *Walworth Mfg. Company*, 60 Fed. 605, 9 C. C. A. 154; *Diamond Drill Machine Company* v. *Kelly Brothers* (C. C.), 120 Fed. 295. The various authorities cited in Judge Hazel's opinion and on the brief of appellee are concerned wholly

with the other defense, prior patenting or publication. (Italics ours.)

As a consequence, Judge Lacombe held the Sundh patent to be invalid because the patentee was not the first inventor, though the first patentee; an application having been previously filed *disclosing* the same invention, though the *claims* were *not for the same subject matter*. In other words, we maintain that this case clearly indicates that such a state of facts as was disclosed was insufficient to establish the third defense under Section 4920, R. S., *but was sufficient to establish the fourth defense*, and that it was the date of the *application as filed*, and not the date of the patent that controlled, the application being a reduction to practice as of its filing date, and showing prior knowledge of the invention as of *that date*.

In brief, then, that while the pleading of the patent *as such* was unavailing because it had not issued and so was not in the prior art under the statute, the pleading of prior *knowledge was* sufficient, and since supported by proof of the earlier filing it prevailed.

So that this case shows that even in the Second Circuit the principle we contend for has been approved.

This case is taken as an illustration of what we believe to be the conclusions that may be derived from the other decisions.

We urgently contend that the rule followed by the Court of Appeals for the Sixth Circuit expresses the correct principle, and the following quotation

from the *Lemley case, supra,* page 3, we think clearly distinguishes between the third and fourth statutory defenses and what must be proved under each, besides distinguishing various cases and showing that the apparent confusion is in large part because of the difference in pleading these defenses.

(2) This court held, in *Drewson* v. *Hartje Co., supra,* 131 Fed. at page 739, 65 C. C. A. 548, that a patent, the filing date of which antedated the filing date of the patent in suit, was prima facie anticipatory; and we have repeatedly accepted and applied that rule (e. g., *Electric Co.* v. *Westinghouse Co.*, 171 Fed. 83, 87, 96 C. C. A. 187; *Jackson Co.* v. *Adler*, May 18, 1917, 243 Fed. 386, — C. C. A. —; *Twentieth Century Co.* v. *Loew Co.*, 243 Fed. 373, — C. C. A. —, May 8, 1917). To rely upon these cases would be sufficient; but the contrary proposition is urged upon us so often and is observed to such an extent in current decisions that it seems to deserve reexamination. The cases, found cited to support the claim that such a patent is not part of the prior art, are collected in the margin. We are satisfied that the confusion arises out of a question of pleading, and has no foundation in matter of substance.

The patent statute (R. S. Sec. 4920 [Comp. St. 1916, Sec. 9466]) catalogues five supposedly independent matters of defense and requires the pleading of those which are to be relied upon. The separation is not analytically perfect; the last clause (*b*) of "third" seems to belong to "fifth," and since the

patentee could not possibly be the first inventor of something that, before his invention, had been patented to or described by another, the entire first clause (*a*) of "third" seems quite unnecessary. However, we have to deal with the statute as it is. The two classes [clauses?] now material are:

"Third. (*a*) That it (the invention) had been patented or described in some printed publication prior to his supposed invention or discovery thereof, or (*b*) more than two years prior to his application for a patent therefor.

* * *

"Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented."

Since an invention is not "patented" and the patent is not "published" until issued, it is apparent that when a patent is pleaded under this third defense, and the fourth defense is not involved, its application date is of no importance whatever. It is equally sure that where the tendered issue is whether the patentee was the first inventor (fourth defense), and it appears that another had made the invention, the *date of that other's patent, or whether he ever had a patent, or whether the prior description was by printing or without, is immaterial; the date of his invention is the vital thing.*

Under the familiar Patent Office rule, the filing of an allowable application is a constructive reduction to practice, and so there must be a presumption that the patentee had made his invention at the date of his filing.

The cases where a substantial change in the invention is made, pending the application, are exceptional, and, of course, he who alleges an exception must prove it. The existence of the presumption is worked out and declared, with perhaps unnecessary care, by the first Circuit Court of Appeals in *Automatic Co.* v. *Pneumatic Co.*, 166 Fed. 288, 293, 92 C. C. A. 206. Hence, it assuredly follows that if a patent in suit was applied for January 15th, and there is nothing to carry the patentee's invention back of that date, and if a patent disclosing the same invention was issued to another in July upon an application filed January 1st, this tends to show that the patentee of the patent in suit was not the first inventor. This has been distinctly held not only in *Drewson* v. *Hartje*, *supra*, but by the Seventh Circuit Court of Appeals (*Barnes Co.* v. *Walworth Co.*, 60 Fed. 605, 606, 9 C. C. A. 154); by Acheson, C. J. (*Westinghouse* v. *Chartiers Co.* (C. C.) 43 Fed. 582, and cases cited on page 588); and by the Second Circuit Court of Appeals (*Sundh Co.* v. *Interborough Co.*, 198 Fed. 94, 97, 117 C. C. A. 280); and it has been expressly recognized and applied by the Supreme Court (*Pope Co.* v. *Gormully Co.*, 144 U. S. 238, 244, 12 Sup. Ct. 637, 36 L. Ed. 420); by Mr. Justice Bradley (*Kearney* v. *Lehigh Co.* (D. C.) 32 Fed. 320, 322, 323); and by the Second Circuit Court of Appeals (*Hillard* v. *Fisher Co.*, 159 Fed. 439, 441, 86 C. C. A. 469; *Otis Co.* v. *Interborough Co.*, 222 Fed. 501, 502, 138 C. C. A. 97).

> Turning to the cases cited contra: *Bates* v. *Coe*, in using the language so often quoted (98 U. S. on pages 33, 34, 25 L. Ed. 68) is speaking solely of "evidence to sustain the second (third) defense," and this restriction has not been observed when it has been quoted as if applicable to all defenses. In *Horton Co.* v. *White Lily Co.* (C. C. A. 7), (213 Fed. 471), the court was considering two patents to the same inventor, a very different situation. In some, as in *Anderson* v. *Collins* (C. C. A. 8), (122 Fed. 451), it is carefully recognized that the ruling involves only the third defense. In others, the state of the pleadings does not appear. Some seem to depend upon a distinction between "anticipation" and "priority of invention," applying the former name to the third defense and the latter to the fourth, though we do not see why "anticipation" is not properly applicable to both. So far as any of the other cases may be distinctly inconsistent with the proposition of the preceding paragraph, we must think them erroneous. [243 Fed. p. 391 at 395–397.] (Italics ours.)

Only a brief comment on the principle case opposed to this view—that of *Farmers' Handy Wagon Co.* v. *Beaver Silo & Mfg. Co.*, *supra*—seems necessary.

In that case it does not appear that either the claims or the unclaimed disclosure in the specification and drawings of the patents introduced to show prior invention under the fourth defense, illustrated the same invention as that claimed in the patent sought to be invalidated thereby. In fact

the court concluded that they were *different inventions;* and did not find that an unclaimed disclosure of the same subject matter as was covered by the claims of the later applicant *was set out in the earlier applications.*

So while the court expressed itself in the statement that the prior art as disclosed in the earlier patents "should be limited to such matters as are included in their several claims," the exact point in issue in the instant case was not apparently a factor in the decision, for the inventions were not the same.

CONCLUSION

We respectfully submit that a patent which claims something that was sufficiently disclosed in an application filed before the application of the patent in issue is invalid because it is not for a "*New*" invention, "*Not Known* by others in this country before the applicant's invention or discovery thereof," and that proof to that effect is sufficient under the fourth defense of Section 4920, Revised Statutes.

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